

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

YOR920030023US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
name _____

Application Number

10/642,615

Filed

August 19, 2003

First Named Inventor

Ali Afzali-Ardakani

Art Unit

1797

Examiner

Yelena G. Gakh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

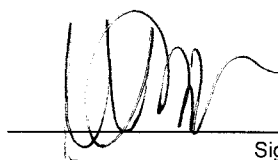
attorney or agent of record.

Registration number 48,317

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Scott M. Tulino

Typed or printed name

703-761-4100

Telephone number

December 19, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Ali Afzali-Ardakni et al.

Serial No.: 10/642,615

Group Art Unit: 1743

Filed: August 19, 2003

Examiner: Yelena G. Gakh

For: MOLECULAR MANIPULATOR, A METHOD OF MAKING THE SAME,
AND A METHOD OF MOVING A NANOSTRUCTURE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Prior to developing a formal Appeal Brief, Appellants submit the following argument for review by more experienced Examiners under the pilot Pre-Appeal Brief Conference. Appellants concurrently file herewith a Notice of Appeal.

Appellants hereby request that the Conference attendees refer to the full argument of Appellants on pages 2-9 of the Request for Reconsideration filed Under 37 C.F.R. § 1.111, filed on August 19, 2008, and do not herein repeat these arguments in their entirety.

In addition to these arguments, Appellants respectfully submit Appellants point out that the test for enablement is “whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.” (See M.P.E.P. § 2164.01; emphasis added by Applicants).

Appellants maintain that the above standard for the enablement requirement has been met.

The Examiner's rejection relies mainly on the assertions that Appellants' disclosure is allegedly "hypothetical" and does not provide "examples" of the synthesis of the claimed molecular manipulator.

Appellants point out, however, that "[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. An example may be 'working' or '**prophetic**'. A prophetic example describes an embodiment of the invention based on predicted results rather than work actually conducted or results actually achieved. An applicant need not have actually reduced the invention to practice prior to filing" (see M.P.E.P. § 2164.02; emphasis add by Applicants). Therefore, Appellants submit that the examples provided in Figures 1 and 2 of the Application are sufficient for purposes of providing an enabling disclosure of the claimed invention.

Furthermore, with respect to the Examiner's allegations that the experimentation required by one of ordinary skill in the art would have been "undue", Applicants submit that "[t]ime and difficulty of experiments are not determinative if they are merely routine." (See M.P.E.P. § 2164.06; emphasis added by Applicants). Applicants submit that the experimentation required by one skilled in the related art to make and use the claimed invention is clearly routine (as is illustrated in the documents submitted in the Information Disclosure Statement filed on August 19, 2003).

Moreover, Appellants submit that since the level of skill in the related art is high, the degree of experimentation that is considered routines is also high. Appellants submit that the amount of experimentation required to make and use the claimed invention is commensurate with the level of skill in the related art.

Serial No.: 10/642,615
Docket No. YOR920030023US1

In view of the foregoing arguments, along with those arguments currently of record, Appellants submit that there exists a clear error in the Examiners' rejection because the Examiner has mischaracterized the standard for establishing enablement.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: December 19, 2008



Scott M. Tulino, Esq.
Registration No. 48,317

Sean M. McGinn, Esq.
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY
LAW GROUP, PLLC**
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 48150